



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,437	12/28/2001	Keith A. Riha	TRM TR000024 DIV	9561

7590

09/30/2003

Steven J. Grossman
GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC
55 South Commercial Street
Manchester, NH 03101

EXAMINER

STAICOVICI, STEFAN

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,437

Applicant(s)

RIHA ET AL.

Examiner

Stefan Staicovici

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Applicants' amendment filed July 7, 2003 (Paper No. 7) has been entered. Claim 1 has been amended. No claims have been added. No claims have been canceled. Claim 1 is pending in the instant application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Filion *et al.* (US Patent No. 5,952,630) in view of Filion *et al.* (US Patent No. 5,448,028) and in further view of Spanjer (US Patent No. 4,654,290).

Filion *et al.* ('630) teach the basic claimed process including, providing an outer skin (26b') formed by vacuum forming (thermoforming), a foam layer (26b'') bonded to said skin, a substrate layer (22b) bonded to said foam layer (26b'') and a at least one switch (30b) embedded in said foam layer (26b'') (see Figure 5 and, col. 3, lines 60-64; col. 5, lines 31-34 and lines 54-61). Further, Filion *et al.* ('630) teach marking of said outer skin layer (see Figure 1).

Regarding claim 1, although Filion *et al.* ('630) teaches marking of said outer skin layer (see Figure 1), Filion *et al.* ('630) does not teach a process of marking said outer skin layer.

Filion *et al.* ('028) teach a printing process for forming indicia (30) on a laminate including an outer skin (28), a foam layer (26) bonded to said skin, a substrate layer (24) bonded to said foam layer (26) and a at least one switch (20) embedded in said foam layer (26), said indicia overlying said embedded at least one switch (20) (see col. 2, line 67 through col. 3, line 23; col. 3, lines 37-61; col. 5, lines 29-43 and Figure 6). Spanjer ('290) teaches that a polymeric material that includes a pigment die changes color upon interaction between said pigment die and a laser beam and forms a marking of a different color than the surrounding material (see col. 1, lines 52-60). Further, Spanjer ('290) teaches laser marking as a replacement for printing, hence teaching laser marking as an equivalent alternative to printing (see col. 1, lines 24-25). Furthermore, it is submitted that the polymeric material of Spanjer ('290) includes a skin layer in which the laser beam is focused in order for the inventions of Spanjer ('290) to function as described. Therefore, it would have been obvious for one of ordinary skill to have provided a colored outer skin and have used a laser marking method as taught by Spanjer ('290) as an alternative to the printing process of Filion *et al.* ('028) to form indicia in the process of Filion *et al.* ('630) because, Filion *et al.* ('630) teaches marking of said outer skin layer and Spanjer ('290) teaches that laser marking and printing are equivalent alternatives and also because, laser marking provides a clearer and more durable marking, while eliminating the extra processing step in the printing process of applying a clear coat over a printed mark. It should be noted that it is submitted that said outer skin is a colored outer skin in the process of Filion *et al.* ('630) in view of Filion *et al.* ('028) and in further view of Spanjer ('290) in order for said process to function as described.

Response to Arguments

4. Applicants' remarks filed July 7, 2003 (Paper No. 7) have been considered.

In response to Applicants' arguments regarding the teachings of EP 0 771 695 A1 and Spanjer ('290) individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants' arguments are drawn to newly presented claim limitations not previously presented and as such Applicant's arguments are moot in view of the new ground(s) of rejection.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1732

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-0396. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM and alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni, can be reached at (703) 305-5493. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Stefan Staicovici, PhD

Stefan Staicovici

Primary Examiner

9/22/03

AU 1732

September 22, 2003